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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/992,928	11/05/2001	Jan Eveleens	NL000591	6950

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EXAMINER

NATNAEL, PAULOS M

ART UNIT	PAPER NUMBER
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2614

DATE MAILED: 06/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/992,928

Applicant(s)

EVELEENS ET AL.

Examiner

Paulos M. Natnael

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on preliminary amendment filed 11/05/01.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4.6.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims **1-10, 12** are rejected under 35 U.S.C. 102(e) as being anticipated by Kobayashi et al., U.S. Pat. No. 6,490,681.

Considering claim **1**, a method of communicating a command to a controllable device (130), comprising the steps of

a) generating a watermark comprising the command, which is to be executed by the controllable device (130), is met by content distribution system, fig.12;

b) generating a watermarked signal (120) comprising the watermark and an information unit (116) to be transmitted to the controllable device (130), is met by the embed visible mark 120, also in fig.12;

c) transmitting the watermarked signal (120) to the controllable device (130) for causing the controllable device (130) to execute the command, is met by the contents distribution system which transmits the image data and added visible mark through the Internet or other means such as transmission of key shown in fig.12.

Considering claim 2, a method as claimed in claim 1, where the watermarked signal (120) is generated in a first domain by outputting a watermark signal representing the watermark to the first domain for merging the watermark signal with an information signal representing the information unit (116) in the first domain, is again met Contents Distribution System which generates watermarked signal with the image signal, and transmits the image data and added visible mark through the Internet or other means such as transmission of key shown in fig.12.

Considering claim 3, a method as claimed in claim 2, where the first domain is one of the acoustic domain and the visual domain, is met by image signal (visual domain) generated as in Fig.12.

Considering claim 4, a method as claimed in claim 2 or 3, where the second domain is the electrical domain.

See rejection of claims 1 and 3;

Considering claim 5, a method as claimed in claim 1, where the command relates to at least one of: control of a physical movement of a part of the controllable device (130), rendering of an audio output by the controllable device (130), rendering of a visual output by the controllable device (130), and adjusting a value for at least one parameter associated with the command, is met by the transmission of key which is associated with rendering rendering of a visual output by the controllable device, i.e., as shown in

fig. 12 the image signal and the embedded mark are rendered on the Electronic fingerprinting system (140), fig.12;

Considering claim 6, An arrangement for remotely controlling a controllable device (130), comprising embedding means (113) for generating a watermark comprising the command, which is to be executed by the controllable device (130); watermarking means (114) generating a watermarked signal (120) comprising the watermark and an information unit (116) to be transmitted to the controllable device (130); output means (115) for transmitting the watermarked signal (120) to the controllable device (130) for causing the controllable device (130) to execute the command; receiving means (131) for receiving the signal in the controllable device (130); decoding means (132) for obtaining the information unit from the signal and obtaining the command from the information unit; executing means (133) for executing the command.

As for claim 6, see rejection of claim 1 and Fig.12 which discloses generating image and watermark, embedding visible mark, transmitted the data using the Internet and receive by the electronic fingerprinting system 140 and displaying signal as invisible mark embedded image after decoding.

Considering claim 7, a controlling device arranged for communicating a command in a first domain to a controllable device, comprising, embedding means (113) for generating a watermark comprising the command, which is to be executed by the controllable device (130), watermarking means (114) generating a watermarked signal

(120) comprising the watermark and an information unit (116) to be transmitted to the controllable device (130), and, output means (115) for transmitting the watermarked signal (120) to the controllable device (130) for causing the controllable device (130) to execute the command.

As for claim 7, see rejection of claim 1 and Fig.12, which discloses generating image and watermark, embedding visible mark, transmitted the data using the Internet and receive by the electronic fingerprinting system 140 and displaying signal as invisible mark embedded image after decoding.

Considering claim 8, a controllable device arranged for receiving a command in a first domain from a controlling device, comprising receiving means (131) for receiving the signal in the controllable device (130), decoding means (132) for obtaining the information unit from the signal and obtaining the command from the information unit, and, executing means (133) for executing the command.

Regarding claim 8, see rejection of claim 1.

Considering claim 9, a computer program product being arranged for causing a processor to execute the method of claim 1, is met by the disclosure on col. 7, lines 29-39, that "A floppy disk is inserted into the floppy disk driver 20. Code or data for a computer program can be recorded on the floppy disk or the hard disk drive 13 (or on such storage medium as the MO 28, the CD-ROM 29 or the DVD 31), or in a ROM 14, so as to interact with an operating system by issuing instructions to the CPU 1 and

implementing the present invention. The program can be executed by loading it into the memory 4. The computer program code can be compressed, or can be divided into a plurality of segments that are stored on or in a plurality of storage media.”

Considering claim 10, a method of presenting an advertisement (430) to a user (420), comprising the steps of generating a watermark comprising the command, which is to be executed by the controllable device (232), the command being related to presenting an advertisement (430); generating a watermarked signal (120) comprising the watermark and an information unit (116) to be transmitted to the controllable device (232), and transmitting the watermarked signal (120) to the controllable device (130) for causing the controllable device (130) to execute the command by generating the advertisement (430) and presenting the advertisement (430) to the user (420).

Regarding claim 10, see rejection of claim 1;

Considering claim 12, a signal (120) comprising an information unit (116) in which a watermark is embedded, the watermark comprising a command to be executed by a controllable device (130).

See rejection of claim 1;

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rhoads, U.S. Pat. No. 6,490,681.

Considering claim 11, a method as claimed in claim 10, further comprising the steps of maintaining a user profile (411) for the user (420) based on a sale of a controllable device (130) to the user (420), determining using the user profile (411) a product that the user is likely to want to buy, and adding an identifier for the product to the command.

Regarding claim 10, Rhoads does not specifically disclose maintaining user profile and determining using the user profile a product that the user is likely to want to buy. However, Examiner takes Official Notice in that such method is notoriously well known in the art, and it would have been obvious to the skilled in the art at the time the invention was made to modify the system of Rhoades by providing the method of maintaining and using user profiling in order to make it easier for the advertiser to identify the type of customers and their likely tendency to buy or utilize certain brands.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi et al., U.S. Pat. No. 6,490,681.

Considering claim 11, a method as claimed in claim 10, further comprising the steps of maintaining a user profile (411) for the user (420) based on a sale of a controllable device (130) to the user (420), determining using the user profile (411) a product that the user is likely to want to buy, and adding an identifier for the product to the command.

Regarding claim 10, Rhoads does not specifically disclose maintaining user profile and determining using the user profile a product that the user is likely to want to buy. However, Examiner takes Official Notice in that such method is notoriously well known in the art, and it would have been obvious to the skilled in the art at the time the invention was made to modify the system of Rhoades by providing the method of maintaining and using user profiling in order to make it easier for the advertiser to identify the type of customers and their likely tendency to buy or utilize certain brands.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Broughton et al. U.S. Patent No. 4,807,031 disclose an interactive video method and apparatus, which decodes the commands embedded in the control data, and selectively execute predetermined actions in response to the data encoded broadcast.


Isnardi et al. U.S. Patent No. 6,037,984 disclose a method and apparatus for embedding a watermark into a digital image or image sequence.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paulos M. Natnael whose telephone number is (703) 305-0019. The examiner can normally be reached on 9:00am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (703) 305-4795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PMN *PMN*
May 31, 2004


MICHAEL H. LEE
PRIMARY EXAMINER